

Applic. No. 10/828,813

Amdt. dated December 12, 2005

Reply to Office action of September 12, 2005

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-30 are now in the application. Claims 25-29 have been withdrawn from consideration. Claim 30 has been added.

Support for claim 30 can be found on page 19, lines 5-9 of the specification where it is disclosed that the filter body can be constructed in accordance with conventional principles such that the passages are alternately closed off, with the result that the entire flow of exhaust gas flows through the heat-resistant filter layer.

Therefore the instant application discloses to a person of ordinary skill in the art that a filter body according to the present invention can have passages, which are alternately closed off. Accordingly, no new matter has been added.

In the second paragraph on page 2 of the above-identified Office action, claims 1-24 have been rejected as being obvious over Cyron (EP 0 134 002 A1) in view of Dias et al. (U.S. Patent No. 5,474,587) (hereinafter "Dias") under 35 U.S.C. § 103.

Applic. No. 10/828,813  
Amdt. dated December 12, 2005  
Reply to Office action of September 12, 2005

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 17 call for, *inter alia*:

at least one boundary region extending from the filter section, the boundary region having a first layer thickness being different than a second layer thickness of the filter section.

The Examiner correctly stated on page 2 of the Office action that the Cyron reference fails to disclose that the boundary region has a first layer thickness being different than a second layer thickness of the filter section.

Cyron discloses a diesel exhaust filter made of wire mesh. The layers of wire mesh have one thickness and do not include filter and boundary sections.

Applic. No. 10/828,813

Amdt. dated December 12, 2005

Reply to Office action of September 12, 2005

Dias discloses a process for producing a porous fluid permeable body, which is heatable and a respective body.

The Examiner refers to Fig. 1 of Dias, which shows a filter body having regions with different thicknesses. Dias explicitly discloses that the diameters that the Examiner refers to are diameters of the entire filter body and indicates a difference in a wall thickness of the filter body. Therefore, Dias does not disclose that a filter layer can be made which has regions of different thicknesses. Accordingly, Dias does not provide any motivation for a person of ordinary skill in the art to provide a filter layer having regions with different thicknesses. Dias only discloses a filter body having different thicknesses. Consequently, a combination of Cyron and Dias would only provide motivation for increasing the thickness of a jacket surrounding the filter disclosed by Cyron.

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest at least one boundary region extending from the filter section, the boundary region having a first layer thickness being different than a second

Applic. No. 10/828,813

Amdt. dated December 13, 2005

Reply to Office action of September 13, 2005

layer thickness of the filter section, as recited in claims 1 and 17 of the instant application.

The Examiner correctly stated that Cyron does not disclose the feature.

Dias discloses fluid permeable body that has a filter body with different thicknesses. Accordingly, Dias does not show or suggest a filter layer having at least one boundary region extending from the filter section, the boundary region having a first layer thickness being different than a second layer thickness of the filter section.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

Furthermore, a person of ordinary skill in the art is not given any motivation to combine Cyron and Dias. More specifically, Dias discloses the formation of a filter body which is electrically heatable. An electric heating is not disclosed in Cyron nor is it disclosed in the instant application. Therefore, a person of ordinary skill in the art does not have any motivation to combine Cyron and Dias.

Applic. No. 10/828,813

Amdt. dated December 12, 2005

Reply to Office action of September 12, 2005

Moreover, it is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Cyron to

Applic. No. 10/828,813

Amdt. dated December 12, 2005

Reply to Office action of September 12, 2005

incorporate the features of Dias, and there is no teaching or suggestion in Dias to incorporate the features of Cyron.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), cert. den., 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Cyron or Dias or to combine Cyron's and Dias's teachings to arrive at the claimed present invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Cyron or Dias or from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only

Applic. No. 10/828,813  
Amdt. dated December 12, 2005  
Reply to Office action of September 12, 2005

present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references themselves must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

Therefore, upon evaluation of the Examiner's comments, it is respectfully believed that the evidence adduced by the Examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

Based on the above-given remarks, claims 1 and 17 are not obvious over Cyron in view of Dias.

Since claims 1 and 17 are believed to be allowable, dependent claims 2-16 and 18-24 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 and 17. Claims 1 and

Applic. No. 10/828,813

Amdt. dated December 12, 2005

Reply to Office action of September 12, 2005

17 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 1 and 17, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-29 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

The fee for one additional dependent claim in the amount of \$50 is enclosed herewith.



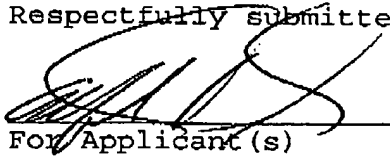
Applic. No. 10/828,813

Amdt. dated December 12, 2005

Reply to Office action of September 12, 2005

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,



For Applicant(s)

**Alfred K. Dassler**  
**52,794**

AKD:cgm

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Lerner and Greenberg, P.A.

Post Office Box 2480

Hollywood, FL 33022-2480

Tel: (954) 925-1100

Fax: (954) 925-1101